

REMARKS

Applicant is in receipt of the Office Action mailed May 13, 2004.

A. Claims

Claims 1, 5, 16, 18, 20, and 26 have been amended. Claim 27 has been added. Claims 1-27 are pending.

B. 35 U.S.C. §103 Rejections

The Office Action rejected claims 1-4, 9-19, and 23-26 under 35 U.S.C. 103(a) as being unpatentable by Sites et al. (US 5,515,159) (hereinafter "Sites") in view of Novak (US 5,497,314) (hereinafter "Novak"). Applicant respectfully disagrees with the rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Neither Sites nor Novak appear to disclose, teach, or suggest, either separately or in combination, "wherein, prior to image processing, an amount of the stored image data substantially corresponds to a size of the first object (emphasis added)" as recited in amended claim 1. Applicant agrees with the Examiner that "...Sites does not particularly teach or suggest an amount of the store image data (sic) substantially corresponds to a size of the first object as claimed (Office Action, page 3)." The Examiner points to Novak at col. 8, lines 37-50 for this teaching:

What is claimed is as follows:

1. A method for automatically recognizing and identifying, without human intervention, a particular object from a set of unknown objects of different sizes, shapes and pictorial characteristics for purposes of customer billing and inventory control, said method comprising: providing a computerized data base for storage of object data sets for all

objects to be identified, the data sets containing information regarding the size and shape of each object and one or more digitized images of pictorial characteristics of each object from various random orientations by which each object can be recognized and identified by the combination of size, shape and pictorial characteristics; (Novak, col. 8, lines 37-50).

Novak does not appear to disclose “wherein, prior to image processing, an amount of the stored image data substantially corresponds to a size of the first object (emphasis added)” as recited in claim 1. The size of the “data sets” of “information regarding the size and shape” and “digitized images of pictorial characteristics” stored by Novak prior to image processing does not appear to depend on the size of the object. For example, Novak teaches:

The digital information regarding an object properly positioned in the housing 4 is imaged onto a two-dimensional charge coupled device (CCD) array, and the digital image created is encoded as a bit value and is directly associated to a pixel location. For example, the current image from video camera 10 might be a matrix of 284x376 pixel elements, each with a grayscale value of from 0 to 255. (Novak, col. 3, line 64- col. 4, line 3).

Novak appears to teach the stored image size is the same (e.g., 284x376) for all objects, prior to image processing, regardless of the size of the object. Novak further teaches:

A frame image of ABCD is created as a first quadrant Cartesian plane after the image boundary is determined with the top/bottom/left/right pixels. The frame image thus created is a subset of the current image and was created by finding the extreme points where image data is resident. (Novak, col. 4, lines 13-21).

Novak appears to disclose initially storing a similar amount of data for all objects and then using image processing to narrow the area used. Applicant respectfully asserts claim 1 and claims dependent thereon are allowable for at least the above reasons.

Amended claims 16, 18, and 26 recite, among others, a similar limitation not disclosed, taught, or suggested by Sites or Novak. Applicant respectfully requests the Examiner withdraw the rejection to claims 16, 18, 26, and claims dependent thereon.

The Office Action has also not stated a prima facie case of obviousness for combining Sites and Novak. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In *re* Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added).

There is no teaching or suggestion to combine Sites and Novak either in the references or in the prior art. To establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In *re* Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In *re* Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

The Examiner is reminded that "it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the

inventor”, *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Applicant submits that neither Sites nor Novak provides a motivation to combine, and so the combination of Sites and Novak for a 103(a) rejection is improper. Applicant further submits that even if Sites and Novak were properly combinable, which Applicant argues they are not, the resulting combination would not teach Applicant’s invention as claimed. Applicant respectfully requests the Examiner withdraw the rejections to claim 1, 16, 18, 26 and claims dependent thereon.

In addition, neither Sites nor Novak appear to disclose, teach, or suggest “wherein the size of the first object is a number of scan lines corresponding to the first object stored by the image acquisition device” as recited in claim 3. For example, neither reference appears to suggest associating a size of the first object with a number of scan lines. Applicant respectfully submits that claim 3 is also allowable for at least the above reasons.

C. Allowable Subject Matter

The Examiner has indicated that claims 5-8 and 20-22 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. (The Examiner cites claims “6-8” in the body of the Office Action, but cites “5-8” on the cover page. In addition, no rejections have been presented for claim 5, and therefore, Applicant assumes the Examiner meant “5-8” in the body of the Office Action.) Claims 5 and 20 have been rewritten to include all limitations of the base claim and any intervening claims. Claims 6-8 and 21-22 dependent on claims 5 and 20, respectively, are also believed allowable for at least the above reasons.

D. New Claims

The cited references do not appear to disclose, teach, or suggest “the image acquisition device discontinuing storage of the image data corresponding to the first object in response to the image acquisition device detecting the absence of the first object

(emphasis added)” as recited in claim 27. The Examiner points to Sites numeral 94 of Figure 6 for this teaching. Sites, numeral 94 of Figure 6 is an EDROM DRAM. Sites does not teach discontinuing storage of the image data in response to detecting the absence of the first object. The Examiner points to Sites for detecting when a particular package is leaving:

An additional sensor 46 is located at the first station behind the front edge position sensor 44₁ for detecting when a particular package 14 is leaving the first station. (Sites, col. 4, lines 6-8).

Sites does not appear to teach any activity in response to the detection of the particular package leaving. Applicant respectfully asserts that Sites does not teach “discontinuing storage of the image data corresponding to the first object in response to the image acquisition device detecting the absence of the first object (emphasis added).” Applicant respectfully asserts claim 27 is allowable for at least the above reasons.

E. Additional Remarks

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-36800/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Request for Continued Examination

Respectfully submitted,



Jeffrey C. Hood
Reg. No. 35,198
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert & Goetzel PC
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800
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